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<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>		Docket Number (Optional) HES 2003-IP-011770U1	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>December 18, 2006</u> Signature <u>Bonnie Bell</u> Typed or printed name <u>Bonnie Bell</u>		Application Number 10/698,293	Filed October 31, 2003
		First Named Inventor Lewis	
		Art Unit 1755	Examiner Marcantoni, Paul

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

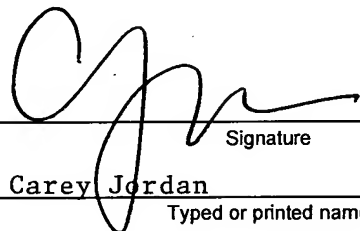
This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant/inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96)
- ☒ attorney or agent of record. 47,646  
Registration number \_\_\_\_\_
- ☐ attorney or agent acting under 37 CFR 1.34.  
Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

  
Signature  
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December 18, 2006  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

LEWIS, *ET AL.*

Serial No.: 10/698,293

Filed: October 31, 2003

Title: "DISPERSANT COMPOSITIONS  
FOR CEMENT COMPOSITIONS  
AND RELATED METHODS"

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Group Art Unit: 1755

Examiner: Paul Marcantoni

Atty. Docket No: HES 2003-IP-011770U1

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ATTY. DOCKET NO.: HES 2003-IP-011770U1  
GROUP ART UNIT: 1755  
SERIAL NO.: 10/698,293  
EXAMINER: PAUL MARCANTONI

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following Pre-Appeal Brief Request for Review ("Request") is being filed in accordance with the provisions set forth in the Official Gazette Notice of July 12, 2005 ("OG Notice"). Pursuant to the OG Notice, this Request is being filed concurrently with a Notice of Appeal. Applicants respectfully request reconsideration of the Application in light of the remarks set forth below.

### **REMARKS**

The Examiner's rejections of Claims 1, 5-12, 14-30, 34-40, and 87-113 contain clear legal and factual deficiencies. Most notable is the Examiner's failure to establish a *prima facie* case for the rejection of the claims under 35 U.S.C. §103. Applicants respectfully request a decision from the Panel that these rejections are improper and an allowance of all pending claims.

In a Final Office Action (which was a first action final) dated August 18, 2006 ("Final Office Action"), the Examiner improperly rejected claims 1, 5-12, 14-30, 34-40, and 87-113, of which claims 1, 30 and 90 are independent, under 35 U.S.C. § 103(a) as being unpatentable over *Sugama, Gay*, or *Etherton* alone or in view of *Chatterji, Bour, Cattanach, Gopalkrishnan*, or *DiLullo Arias*. (Final Office Action at 3, 5-7.) After Applicants filed a detailed response to the Final Office Action, the Examiner mailed an Advisory Action on November 20, 2006 ("Advisory Action") maintaining those rejections.

**A. The Examiner Has Failed to Establish a *Prima Facie* Case for Obviousness.**

The Final Office Action did not establish a *prima facie* rejection of all the claims in the application. Independent claims 1, 30, and 90 are directed to various methods involving cement compositions "comprising a cement, and a dispersant composition, the dispersant composition comprising a surfactant, a hydrolyzed protein, and a defoamer, wherein the defoamer is present in an amount sufficient to prevent foaming of the dispersant composition." The Examiner relies on *Sugama, Gay*, and *Etherton* to provide the teachings of a cement composition comprising a dispersant composition that comprises a surfactant and a hydrolyzed protein. Neither *Sugama, Gay*, or *Etherton* teach a dispersant composition that further comprises a defoamer.<sup>1</sup> Recognizing this, the Examiner combines *Gopalkrishnan* with these references to provide the teaching that it is old to add defoamers to cement compositions. However, the Examiner should not have combined these cited references because no motivation, teaching or suggestion exists to combine *Sugama, Gay*, or *Etherton* and *Gopalkrishnan* for at least the reasons described in Applicants' Response dated October 17, 2006 at pages 6-8 and discussed in further detail below.

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<sup>1</sup> In addition, Applicants do not concede that the hydrolyzed proteins and surfactants present in the cement compositions disclosed in *Sugama, Gay*, or *Etherton* would function as a dispersant. (See Response to Office Action pages 12-21.)

To illustrate, the Final Office Action states that the motivation to combine *Sugama*, *Gay*, or *Etherton* and *Gopalkrishnan* is that:

[T]he added use of a defoamer in a well cement composition would is [sic] notoriously known in the art and is routinely used as an obvious design choice for one of ordinary skill in the art...

The applicants have allege [sic] and argue [sic] that the primary references are directed to foamed cement composition and it would appear that applicants hold the position that because these primary references teach foamed composition it is contrary to these references teachings and objectives. In other words, adding a foaming agent and defoaming agent together would not occur. The examiner disagrees and refers applicants to their own Halliburton patent to Chatterji et al. '844 for well cements wherein they teach that adding both a defoaming agent and a foaming agent and even a foam stabilizer is old and known in the art (see col. 3, lines 15-21 of Chatterji '844). It is thus not contrary to add both defoamer and foaming agent in the same cement composition including well cement compositions.

(Final Office Action, pages 5-7.) Applicants disagree. *Chatterji* '844 teaches a method wherein a defoamer may be added to a cement composition prior to the step of foaming the cement. In particular, *Chatterji* '844 discloses that "[t]he defoaming agent prevents foaming during mixing of the cement composition prior to foaming the composition." (*Chatterji* '844, col. 6, lines 65-66.) Thus, *Chatterji* '844 does not disclose that it is old and known in the art to add a defoamer to a dispersant composition in an amount sufficient to prevent foaming of a dispersant composition.

The proposed combination of adding a defoamer "in an amount sufficient to prevent foaming of the dispersant composition," to a foamed cement composition would render *Sugama*, *Gay*, or *Etherton* inoperable for their intended purposes.<sup>2</sup> More specifically, *Sugama* is directed to a high temperature lightweight foamed cement. *Sugama* explicitly provides that a foaming agent is necessary in the cement compositions disclosed therein to "introduce air bubbles" into the cement and thus, when "these discrete bubbles are subjected to high pressure conditions, and are chemically and physically stabilized . . . the result is a hardened foam cement with the suitable compressive strength, low water permeability, and low gas permeability needed to stably withstand geothermal well conditions." (*Sugama*, col. 2, l. 59 - col. 3. l. 7.)

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<sup>2</sup> See MPEP 2143.01 ("If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)).

*Gopalkrishnan* teaches that defoamers are “added for their deaertrainment properties imparted to the resulting cement composition.” (*Gopalkrishnan*, col. 6, ll. 46-50.) Therefore, it would be contrary to the teachings of *Sugama*, and would render the cement compositions disclosed in *Sugama* inoperable for their intended purposes, to include a defoamer “in an amount sufficient to prevent foaming of the dispersant composition” that would effectively remove the air bubbles necessary for the cement composition to produce “a hardened foam cement with the suitable compressive strength, low water permeability, and low gas permeability needed to stably withstand geothermal well conditions.” (*Sugama*, col. 2, l. 59 - col. 3, l. 7.)

Similarly, *Gay* teaches a method for transporting particulates through pipelines or boreholes by “incorporating a foaming agent into mixtures of solid particulates and then forming a foam within the mixture prior to transport to increase the flowability of the solid particulates.” (*Gay*, col. 1, ll. 10-15.) *Gay* further provides that a “benefit to this method of incorporating a foaming agent into the particulate mixture is that the pressure required to pump the material is reduced . . . [t]he use of the foaming agent therefore allows the pumping of particulates that would have otherwise been unpumpable.” (*Gay*, col. 3, ll. 56-63.) While *Gay* does disclose that after “the material has been transported to its placement area, the air in the foam may be removed by a variety of methods,” which may include the addition of a defoamer, it does not follow that there would then be motivation to add a defoamer to the composition disclosed in *Gay* in an amount sufficient to prevent foaming of the dispersant composition. Rather, *Gay* explicitly provides that the use of a foaming agent to create a foamed composition is what allows otherwise unpumpable materials to be pumped. (*Gay*, col. 3, ll. 56-63.) Thus, the addition of a defoamer in an amount sufficient to prevent foaming of the dispersant composition would be contrary to the teachings of *Gay*, and would render the invention disclosed in *Gay* inoperable for its intended purpose.

In addition, *Etherton* teaches a method and apparatus for producing foamed concrete. More specifically, *Etherton* states that “low density foam concrete is preferably formed by adding to the concrete mix a preformed foam in which the air is already entrained...so as to ensure a high void volume.” (*Etherton*, col. 2, ll. 47-51). *Gopalkrishnan* teaches that defoamers are “added for their deaertrainment properties imparted to the resulting cement composition.” Therefore, it would be contrary to the teachings of *Etherton*, and would render

the cement compositions disclosed in *Etherton* inoperable for their intended purpose, to include a defoamer in amount sufficient to prevent foaming of the dispersant composition.

Therefore, for at least the reasons cited above, the proposed combination of *Sugama, Gay*, or *Etherton* with *Gopalkrishnan* is improper because, at a minimum, it would render *Sugama, Gay*, or *Etherton* inoperable for their intended purposes. For at least this reason, a *prima facie* case of obviousness has not been established. Furthermore, Applicants assert that claims 1, 5-12, 14-30, 34-40, and 87-113 are also patentable over *Sugama, Gay*, or *Etherton* in view of *Chatterji, Bour, Cattanach*, or *DiLullo Arias* for the same or analogous reasons. Accordingly, Applicants submit that these claims should be allowed.

### **CONCLUSION**

In light of the above remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections. Applicants further submit that the application is now in condition for allowance, and earnestly solicit timely notice of the same. Applicants hereby petition under the provisions of 37 C.F.R. § 1.136(a) for a one-month extension of time to file these papers, up to and including December 18, 2006. The Commissioner is hereby authorized to debit should the Deposit Account of Baker Botts L.L.P., No. 02-0384, in the amount of \$120.00 for the fee under 37 C.F.R. § 1.17(a)(1) for the one-month extension of time to file this response. Should the Commissioner deem that any additional fees are due, including any fees for extensions of time, Applicants respectfully request that the Commissioner accept this as a Petition Therefor, and direct that any additional fees be charged to the Deposit Account of Baker Botts L.L.P., No. 02-0384, Order Number 063718.0341.

Respectfully submitted,



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